

Office Action Summary

Application No.

10/607,898

Applicant(s)

GRAHAM ET AL.

Examiner

RAMY M. OSMAN

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-8,10-12,16-19,21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5-8,10-12,16-19,21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. This action is responsive to amendment filed on December 20, 2007, where Applicant amended claims 1,8,12,19, and cancelled claims 3,4,9,14,15,20. Claims 1,5-8,10-12,16-19,21,22 remain pending.

Response to Arguments

2. Applicant's arguments in light of the amendments filed 12/20/2007, with respect to the rejection of claims 1,5-8,10-12,16-19,21,22 have been fully considered and are persuasive. Thus the previous rejection of claims 1,5-8,10-12,16-19,21,22 has been withdrawn. However, new rejections are presented which require Applicants action in order to place the claims in condition for allowance.

3. Applicant has not pointed out where the amended claim limitations are supported in the specification. (See MPEP chapter 2163.03 section (I.) and chapter 2163.04 section (I.) and chapter 2163.06). In any subsequent response, Applicant is requested to provide support for the amended limitations.

Claim Rejections - 35 USC § 101

4. Claims 1,5-7 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 1 for example recites "*A rights-managed email... the email comprising*". If indeed Applicant is attempting to claim an "*email*", then this is nothing but a data structure which does not fall within any of the statutory categories. The claim is not directed

Art Unit: 2157

to a process since its not a series of steps. The claim is also not directed to a machine since its not a device(s), nor directed to a manufacture since its not produced from raw materials. And it is also clearly not directed to a composition of matter and is therefore nonstatutory. **See MPEP Chapter 2106.01 Section I.** To make these claims statutory, the claims must reflect a hardware embodiment.

5. Claims 19,21,22 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. For example, claim 19 recites, “*A computer readable medium having stored thereon...*”. According to paragraph 46 of Applicants specification, “*computer readable medium*” encompasses “*storage media*” and “*communication media*”. Lines 19-30 of paragraph 46 state that “*communication media*” embodies signals, carrier waves etc. Therefore, it is clear that the scope of the claimed “*computer readable medium*” is intended to cover communication media including signals, carrier waves etc. It is the office’s position that this does not fall within any of the statutory categories and is therefore not patentable subject matter. **See MPEP Chapter 2106 Section IV.B.¶4 and Chapter 2106.01.** To make these claims statutory, it is suggested to reword them to “*computer readable storage medium*”.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1 and 12 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The preamble of the claims mention a license associated with protected content,

Art Unit: 2157

however the body of the claims fails to contextualize the license. It therefore appears that the claims are lacking/omitting essential steps, similar to what are recited in corresponding independent claims 8 and 19. In claim 1 for example, lines 9-11 appear to be missing a step wherein if the recipient is enabled by rights data, then the recipient receives a license from the rights management server which allows the recipient to render the protected content. The claim is silent in regards to issuance and review of the license. Claim 12 has similar deficiencies.

The respective dependent claims are rejected since they inherit these deficiencies.

8. Claims 8,19 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. For example, lines 19-21 of claim 8 recites “*such license... also including the decryption key from the rights data...*”. The claim is not clear as to whether the decryption key is indeed “*from the rights data*”. This is because lines 6-9 mention that the decryption key is from the rights management server. Furthermore, the decryption key should more appropriately be referred to as the “*encrypted decryption key*” so that it is clear that it is from the server. Claim 19 has similar deficiency.

The respective dependent claims are rejected since they inherit these deficiencies.

9. Claims 8,19 recites the limitation "the decrypted content" in the last line of the claim. There is insufficient antecedent basis for this limitation in the claims since there is no previous mention of actually decrypting the content.

Allowable Subject Matter

10. Claims would be allowable if rewritten or amended to overcome the above-mentioned rejections, set forth in this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RAMY M. OSMAN whose telephone number is (571)272-4008. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RMO
March 23, 2008

/Ramy M Osman/
Primary Examiner, Art Unit 2157